

Remarks

The present Amendment is made in response to the Office Action dated May 11, 2007, and identified as Paper No. 20070509. Claims 1-17 are pending.

In the Action, the Examiner rejected claim 6 under 35 U.S.C. § 112, ¶ 2 for the use of the term “said chamber.” The Examiner also rejected claims 1-2, 5, and 7 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,843,267 to K.A. Anderson (“*Anderson*”). Claims 3-4, 6 and 8-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Anderson* in further view of U.S. Patent No. 4,260,489 to George Greig, et al. (“*Greig*”) and U.S. Patent No. 3,438,502 to H. Schmidt, Jr., et al (“*Schmidt, et al.*”).

I. Rejection of Claim 6 under 35 U.S.C. § 112, ¶ 2

Claim 6 was previously amended to depend from a prior claim (i.e., claim 3) that recites “a chamber” and thus provides an antecedent basis for “said chamber” as recited in line 1 of claim 6.

II. The proposed combination of *Anderson*, *Grieg*, and *Schmidt* does not render claims 1-6 obvious under 35 U.S.C. § 103

Claim 1 has been amended to include the limitation of dependent claim 3. Thus, no new matter has been added to the claims. Claim 3 (now claim 1) was initially rejected in view of a combination of *Anderson*, *Grieg*, and *Schmidt*. This combination is improper under 35 U.S.C. § 103 and does not render what is now claim 1 obvious for several reasons.

First, the Examiner failed to identify any motivation or suggestion for making the proposed combination. MPEP § 2143 (“there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings”) Although the motivation does

not have to be express and may be found anywhere in the prior art, including the knowledge of one of skill, the Examiner failed to identify any such motivation in the prior art and simply proposed the combination of references without explaining why one of skill would make the proposed combination. Accordingly, the Examiner's proposed combination is the product of improper hindsight analysis and cannot support the obviousness rejection.

Next, even if there is a proper motivation to make the proposed combination, the combination is simply not possible. *Anderson* teaches upwardly positioned filter elements, while *Schmidt* teaches a downward configuration. The Examiner failed to explain how these completely opposite systems could be combined to create a working system. Indeed, *Anderson* would not work if modified according to *Schmidt* as it requires a completely opposite configuration. Accordingly, the proposed modification would violate the rule that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. See MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Finally, even if *Anderson* was modified according to *Schmidt* and *Grieg*, it would not include all of the elements of the claimed invention. MPEP 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") In particular, the claimed invention requires a candle housing that (1) is **removably positioned** in the rack, and (2) defines a chamber **above** the mounting plate. The proposed combination fails to disclose these limitations. The candle housings of all three references are fixedly attached to the rack, if one is even used (it is the filter elements that are removable, not the housing), the opposite of what is recited in claim 1. The candle housings of the proposed prior art combination also lack a chamber **above** the mounting plate as recited in claim 1.

III. *Anderson* does not anticipate claim 7 under 35 U.S.C. § 102

A rejection under 35 U.S.C. § 102 requires that the reference include each and every limitation recited in the claims. MPEP § 2131 (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”). All of the elements of claim 7 are not disclosed by *Anderson*; thus the claim is not anticipated.

Claim 7 calls for a filter vessel having a rack that may be slid into and out of a compartment. More importantly, claim 7 calls for the rack to have a male connector that engage a corresponding female connector in the compartment, and the female connector must be further connected to an outlet pipe for clean oil discharge. Thus, the rack is fluidly engaged to the outlet pipe of the compartment when the rack is inserted into the compartment due to the cooperation between the corresponding male and female connectors.

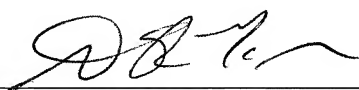
Anderson does not disclose the claimed male, female, and outlet pipe connections. Instead, the outlet pipe is already fixedly connected to the rack and slides into and out of the filter tank along with the filter assembly. In fact, there is no connection made at all between the tank and rack in *Anderson*, as the fluid to be filtered is drawn via suction into the filter leaves from the cavity of the tank – the fluid flow is actually the opposite of what is claimed in claim 7. The outlet pipe is directly connected to the rack, rather than the compartment as required by claim 7. The rack of *Anderson* thus does not have a male connector, the compartment does not have a female connector, and a female connector in the compartment is not connected to an outlet pipe for withdrawing clean oil, as clearly and specifically required by claim 7.

Reply to Office Action dated May 11, 2007
Application No. 10/776,836
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In view of the foregoing amendments as supported by these remarks, the Examiner's reconsideration and allowance of the present application is respectfully requested. If the Examiner believes that a telephone conference will expedite handling of the present application, please contact the undersigned at (315)218-8515.

Respectfully submitted,

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